

No. 1900

IN THE
United States Circuit Court of Appeals

FOR THE
NINTH CIRCUIT

JOHN KITCHEN, JR., CO.
Appellant

vs.

ALEXANDER LEVISON
Appellee

Brief for Appellee

JOHN H. MILLER,
WM. K. WHITE,
For Appellee.

FILED

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APPELLEE'S BRIEF.

This case comes before this Court at this time on an appeal from an interlocutory decree of the Circuit Court of the United States for the Northern District of California, granting a permanent injunction against the further infringement of claims 3, 4 and 5 of United States Reissue Letters Patent, Number 12,005, granted on July 1, 1902, to Alexander Levison (the appellee) for a "Manifold Book."

Fig. 1

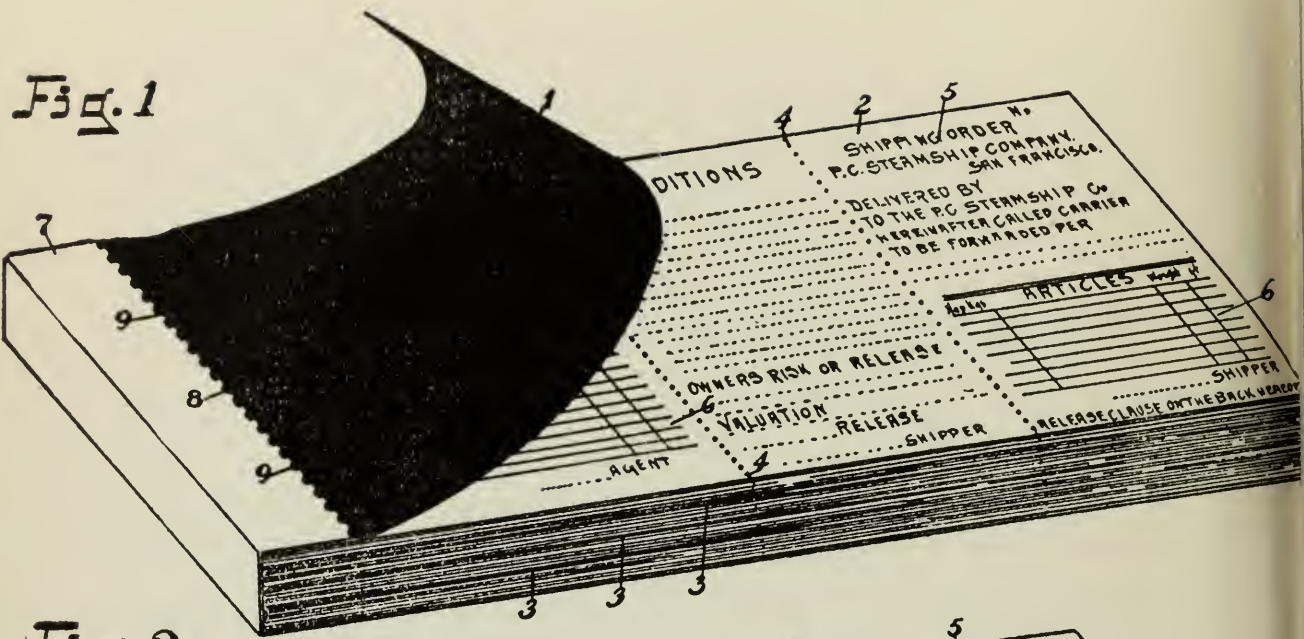


Fig. 2

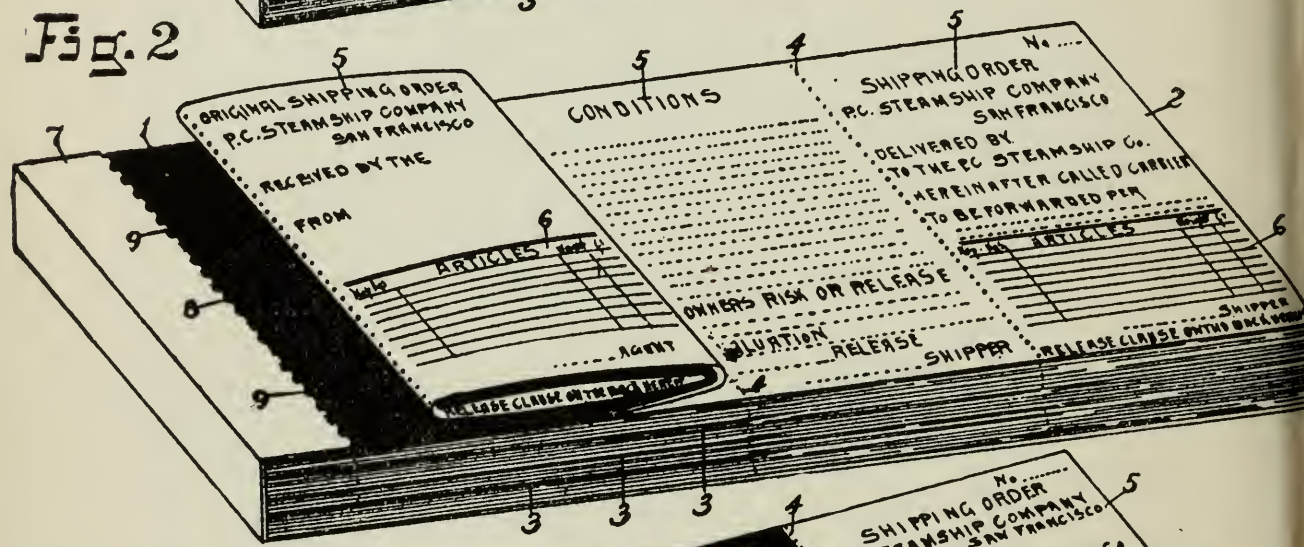
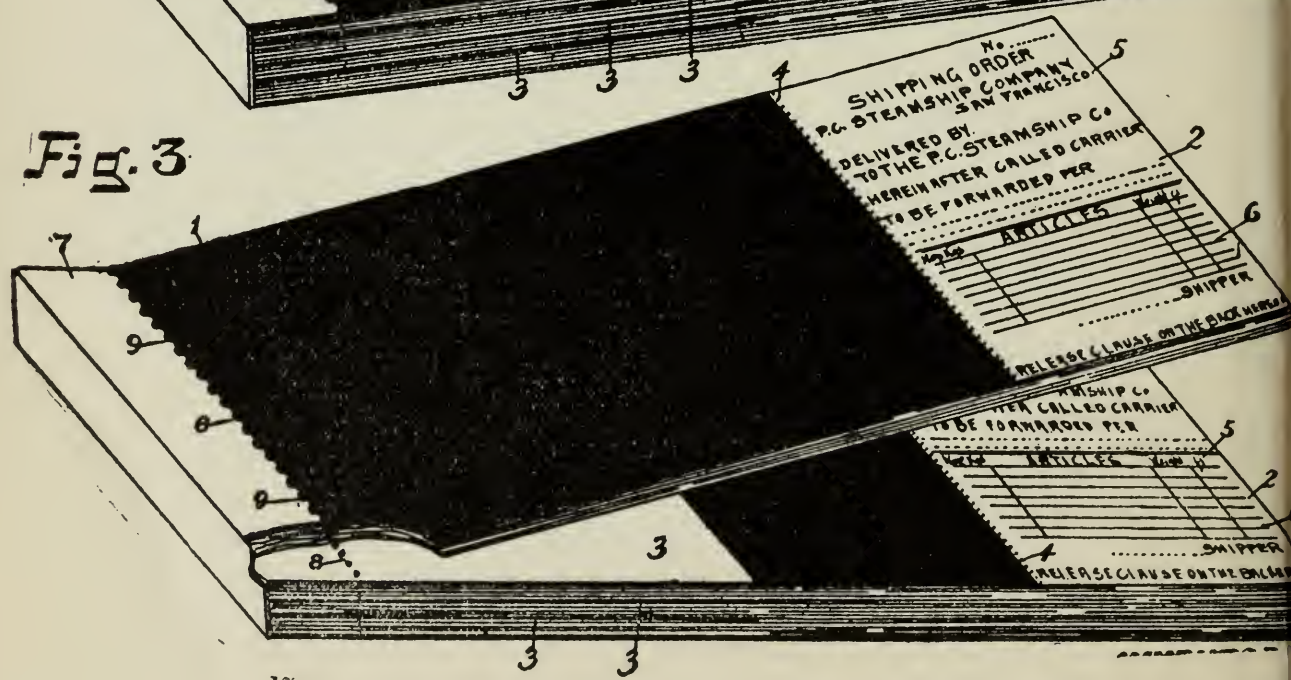


Fig. 3



ARGUMENT.

The defense most relied on is want of invention. It is contended that the change made by Mr. Levison in prior devices was so simple that it was an obvious thing to do. The old answer to this argument is the best answer: "No one did it before."

The invention disclosed in the patent in suit relates to an improved manifold receipt book for mercantile, railway, express, or other uses.

As said by Mr. Levison in the patent:

"The object of my invention is to provide a book of this character which shall be convenient in use, economical in the number of carbons required, which shall give secure protection against alterations and forgeries, and the sheets of which can be readily and conveniently placed on record after the impression has been taken."

On the opposite page are reproduced the three figures of the patent.

Referring to these figures of the patent, it is said therein:

"In the accompanying drawings, Figure 1 is a perspective view of one of my improved manifold-books before use. Fig. 2 is a similar view showing the position when folded for use; and Fig. 3 is a perspective view of the book, a number of sheets being turned up and the book being broken away to show a cardboard backing and carbon-paper.

“Referring to the drawings, it will be seen that my improved manifold-book is formed in sections, each section comprising in order, first, a carbon-sheet 1, of about two-thirds the width of the book, then below said carbon-sheet 1 a number of sheets 2, of ordinary paper, the full width of the book, then a sheet 3 of hard thick cardboard. Each record-sheet outside the stub 7 is divided into three substantially equal parts by vertical lines of perforations 4, said parts having suitable printed matter 5 and blank lines 6, whereon to inscribe the desired record. The carbon-sheets 1 are of sufficient width to extend over two of said parts, while the cardboard backing 3 occupies the width of the inner parts only of the sheets above it. The record-sheets and the cardboard backings are attached to stubs 7 along lines of perforations 8, so that they can be readily detached from said stubs, and said stubs and one side of each carbon-sheet are all bound together to form a book.

“In use the record-sheet is first folded on the outer line of perforations 4, so as to cover about one-half of the carbon-sheet, and it is then folded in the same direction on the second line of perforations, so that the carbon is now folded inside of the record-sheet, as shown in Fig. 2. The record will now be written upon what was the back of the middle portion of the sheet when it was flat and unfolded, which will now, however, have come to the top. The carbon-sheet is double or carbonized on both sides, so that a copy of the record will be made upon each of the two terminal parts of the sheet. Also an inverted or backhanded copy of the writing will be formed upon the back of each part except the inner

one. This latter feature gives additional security against subsequent alteration of the record, since it is difficult to erase and rewrite both the original and the reverse copy.

“The advantages of the above construction are that any kind of paper can be used for the record-sheets, and the construction does not require any transparent paper. The carbon naturally falls into the position for use for the next record-sheet when one record-sheet has been removed and the record-sheet is very readily folded in the desired manner, the fold being twice in the same direction. The device is economical of carbon paper.”

The claims, held by the lower court to have been infringed, read as follows:

“3. A manifold book comprising in order a double carbon-sheet, and a plurality of recording-sheets, the record-sheets outside the stubs being divided into three substantially equal separable parts, and the carbon-sheet extending the width of two of said parts, said recording-sheets having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon sheet being all bound together to form a book, substantially as described.

“4. A manifold-book comprising in order a double carbon-sheet, and a plurality of recording-sheets, each of said sheets outside the stubs being divided into a plurality, not less than three, of substantially equal separable parts, and the carbon-sheet extending the width of said parts except the

outermost, said recording-sheets having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon-sheet being all bound together to form a book, substantially as described.

“5. A manifold-book comprising in order a double carbon-sheet, and a plurality of recording-sheets, each recording-sheet outside the stub being divided into a plurality not less than three of separable parts joined along lines of perforations, each part being not greater than the part next it on the side toward the stub, and the carbon-sheet extending the width of the whole of said parts except the outermost, said recording-sheet having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon-sheet being all bound together to form a book, substantially as described.”

It will be noted that claims 4 and 5 are not limited to record sheets divided into three parts. Such claims are broader than claim 3. If the defendant infringes claim 3, it necessarily infringes claims 4 and 5. We, therefore, shall discuss only claim 3.

The Levison invention is a simple one, and as with many valid patents, the construction may seem to some persons obvious after it has been disclosed by the patentee; but as stated by the Court of Appeals for the Second Circuit, in *United Fastener Co. vs. Bradley*, 149 Fed., 222:

“This Court has repeatedly upheld patents for similar improvements, *the test being not the simplicity of the device, but the difficulties overcome and the results accomplished.*”

“The invention belongs to that large class which has ever been treated with liberality by the courts, when the inventor by an apparently simple change, addition or transposition of parts, has converted imperfection into completeness.”

Wagner Co. vs. Wychoff, 151 Fed., 590.

“It may seem a small thing, involving no great ingenuity, in ordinary pipe coupling to merely make the spud of brass, leaving the other parts unchanged; but considering the efforts of others in the same direction, and the various expedients resorted to, to obtain an easily detachable, and at the same time a steam and water tight joint, *the simplicity of the device confirms rather than detracts from the invention, something more than ordinary mechanical skill being required to go so directly to the mark.* Nor is it of any consequence that the well known principle is made use of, that iron against brass will not rust. It is not necessary in order to make out invention that new qualities shall be evolved. It is sufficient if old ones are novelly and inventively applied.”

Western Tube Co. vs. Rainear, 156 Fed., 52.

“Slight changes in appearance, may bring about radical changes in results. Invention is not to be slighted because the changes are slight.”

National M. Casting Co. vs. American Steel Foundries, 182 Fed., 636.

The Court of Appeals for the First Circuit, in *Decoco Co. vs. Gilchrist*, 125 Fed., 298, said:

“To obtain absolute simplicity is the highest trait of genius.”

THE PRIOR ART.

In considering the prior art, it should ever be borne in mind that the test of invention is “not the simplicity of the device, but the difficulties overcome and the results accomplished.”

The progress in this art is illustrated by Complainant's Exhibits D to R, inclusive. By tracing the development in the art by means of these exhibits, it will be seen that many inventors were endeavoring to reach the goal finally won by Mr. Levison. He took the last step and “converted imperfection into completeness.”

Exhibit D (Rec., 210) is a receipt book consisting of a number of leaves, each of which is divided into three sections. Upon each section of the leaf is the same printed form. To obtain three copies of the receipt it is necessary, in using this book, to fill in the blanks in each section of the leaf. In this book no carbon is used for the purpose of doing away with the labor of writing the entries three times to secure the original receipt and two copies thereof.

Exhibit E (Rec., 211) is a receipt book consisting of a number of series of leaves. Each series consists of three sheets of different colors, one above the other, and each having the same form of receipt printed thereon. To secure three copies of the receipt by the use of this book, two loose sheets of semi-carbon are used. One semi-carbon is placed between the first and second sheets of the series and the other semi-carbon sheet is placed between the second and third sheets of the series. The entries made upon the first sheet of the series is transmitted by the two semi-carbons to the second and third sheets of the series. It is apparent that this book is a great improvement on Exhibit D, as three copies of the receipt are obtained by one writing of the entries. The various sheets of the series are of different colors to aid the user of the book in placing the loose carbon sheets between the sheets with the printed forms thereon. There are, however, many objections to this book. In using it, one is required to handle the loose semi-carbon sheets, which are smutty. It is difficult to quickly insert said loose carbon sheets in the proper place in the book and the same are always apt to be mislaid or lost. These carbon sheets are also apt to become folded or creased by constant handling and this destroys their efficiency.

This form of book is also objectionable for the reason that the manufacturer thereof is unable to predetermine and limit the use of the carbon sheets. For instance, if the carbon sheets used with the book are capable of

transmitting fifty impressions and the book contains one hundred original receipt forms, the user of the book may attempt to make more than fifty triplicate receipts by use of the same carbon sheets, thus obtaining indistinct copies. (Rec., 212).

Exhibit F (Rec., 213) is similar to Exhibit E, but in order to facilitate the handling of the loose carbon sheets, one corner of the original and one corner of the duplicate receipt sheet is cut off, so that the corner of the original receipt sheet does not extend as far as that of the duplicate receipt sheet and the corner of the duplicate sheet does not extend as far as that of the triplicate receipt sheet. By this construction, the user of the book can more readily distinguish between the original and duplicate sheets and between the duplicate and triplicate sheets. This was an advantage, as it facilitated the placing of the semi-carbon sheets between the proper receipt sheets. *This book, Exhibit F, shows that the necessity of handling the loose carbon sheets in Exhibit E was an objectionable feature thereof, and that this book was made for the purpose of eliminating, to some extent, such objectionable feature, by making it easier for the user to insert the two semi-carbons in their proper places.*

Exhibit G (Rec., 215) is a book consisting of a sheet of yellow paper followed by a sheet of thin transparent paper and then by a sheet of pink paper. On each of these sheets is printed the same form. The use of the transparent paper is to eliminate the necessity of hand-

ling *two* loose semi-carbons, which must be done in using the books above referred to.

In using Exhibit G, a double carbon, or sheet carbonized on both sides, is inserted between the transparent sheet and the third sheet of the series. An entry on the first sheet of the series is transmitted by the carbon to the under side of the transparent sheet and to the upper face of the third sheet of the series. The second sheet of the series being transparent, the entry transmitted by the carbon to its under side can be seen and read.

This book, Exhibit G, is an improvement on the previous books of the art, as only one sheet of carbon is required in making the original and two copies of the receipt. The necessity of using only one double carbon sheet is a great advantage over the use of two semi-carbons, as thereby the user of the book is saved a great deal of time and labor in handling and inserting the carbon sheets between the proper recording sheets preparatory to making out a receipt.

Exhibit H (Rec., 216) is a book made in accordance with the specification and drawings of the Barlow patent, Defendant's Exhibit No. 1. Said patent was issued in 1884. This book consists of a series of leaves, each divided, by lines of perforations, into three sections. Upon each section is printed the same form. A loose double carbon of the length of two of the sections of the printed sheet is used with this book, so that

three copies of the receipt are obtained with one writing of the entries.

In the Barlow patent it is said:

“In using the paper having both faces carbonized, a sheet of sufficient size to cover two of the three sections of each blank is employed. Such a sheet is laid over the printed side of section A and the unprinted side of section B. The section C is now folded to the left and laid upon the copying-paper covering the unprinted side of the section B. Then the two sections B and C with the interposed copying-paper are folded to the left and laid upon the copying-paper covering the section A. The printed surface of the section B becomes the uppermost, as the result of folding the blank in the manner described, and this section is accordingly written upon with a pencil and the matter written is duplicated upon each of the sections A and C.”

That the patentee Barlow appreciated the defects in the books of the prior art and was endeavoring to remedy such defects is seen from the following quotation from his patent:

“It will be seen that with one blank sheet, and with *a single sheet of carbon-paper*, two duplicates of the written matter are produced, whereas *two* detached sheets of copying-paper have heretofore been necessary to get the same number of copies. *The old method is objectionable on account of the number of sheets to be adjusted and cared for, and to the shipping clerk, who carries the sheets from*

place to place, the handling and care of the sheets is a source of great annoyance."

That Barlow almost did what Levison, years later, did, cannot be denied. Barlow, however, failed to take "the last step," the step necessary to convert "imperfection into completeness." Although Barlow reduced the number of carbon sheets theretofore required to make three copies, he failed to eliminate entirely the use of loose carbons, which, he admits, "are a source of great annoyance." He perceived the objections to the use of loose carbon sheets but was unable to perceive a way of eliminating the same in a tripling book.

Levison perceived the possibility of binding the carbon sheets with the stubs of the record sheets of the book, so that the carbon sheets would always be in their proper place and the user of the book would thereby be relieved of the annoyance of handling and inserting the same. He not only perceived the possibility and feasibility of providing means for holding the carbon sheets in their proper place in the book, but he also perceived the possibility of the manufacturer of the book determining the life of the carbon sheets and inserting the same in the book at such intervals that the user thereof could not make more copies with a single carbon than such carbon was adapted to make.

The change made in the imperfect Barlow book by Mr. Levison was a simple one, but it could not have

been an obvious change for otherwise Barlow would have made it. We know by his expressed statement that Barlow appreciated the objections to the use of loose carbons in triplicating books, and we know he was unable to provide a means for *entirely* eliminating the use of the same. His efforts only resulted in reducing the number of such loose carbons used in such books. Barlow, by his own admissions, was seeking the same results finally secured by Levison some fifteen years later. In view of Barlow's unsuccessful efforts to secure such results, can it possibly be held that the means of securing such results were obvious?

"It is easy after the event to see how simple an act turned failure into success," says the Court of Appeals for the Seventh Circuit in *Streator Cathedral Glass Co. vs. Wire Glass Co.*, 97 Fed., 957.

"It is this capacity for accomplishing results, this faculty of seeing what others fail to see and hearing what others fail to hear, which has always distinguished success from failure and the inventor from the mechanic."

Frost Co. vs. Cohn, 119 Fed., 505.

As said by the Supreme Court:

" . . . the invention consists rather in the idea that such change could be made, than in making the necessary mechanical alterations."

Hobbs vs. Beach, 180 U. S., 393.

Exhibit I (Rec., 220) consists of a series of leaves, the first sheet of each series being of thin, transparent paper. The second sheet of the series is of yellow paper and twice the length of the transparent sheet. The yellow sheet is divided into two sections. In using this book, a double carbon is placed between the transparent sheet and the inner section of the yellow sheet. The outer section of the yellow sheet is then folded to the left over the transparent sheet. The entries written upon the outer section of the yellow sheet are transmitted to the under side of the transparent sheet and to the upper side of the inner section of the yellow sheet. This book was supposed to be an improvement on the Barlow book by reason of the carbon sheet being smaller and of the length of only one section of the printed sheet. Of course, a small loose carbon sheet is more easily handled than a larger one and is less apt to become creased or crumpled. Exhibit I came on the market after the date of the Barlow patent, so it will be seen that the "simple change" made by Levison in the Barlow book was not obvious to the creator of this exhibit book. Levison "*succeeded where others failed.*"

Exhibit K (Rec., 221) consists of a number of series of leaves, the first sheet of each series being smaller than the second sheet thereof and the second sheet being smaller than the third sheet thereof. The second sheet is transparent and a double carbon is placed between the second and third sheets for transmitting the entries

made on the first sheet. The sheets are of different sizes to enable the user to more readily insert the carbon at the proper place. This book also shows the efforts of others to remedy the defects in the Barlow book due to the difficulty of handling and inserting at the proper place the large, loose carbon sheet used therewith. Regarding this matter, the witness Harry Levison said:

“A. . . . In fact, the thing strived at in all these books was to facilitate the handling of the carbons” (Rec., 222).

Exhibit L is a book made in accordance with the Bengough patent, defendant's Exhibit 7 (Rec., 222). This patent was issued in 1896 and, in our judgment, conclusively shows that the step, taken by Mr. Levison, was not an obvious one. This patent discloses an obviously impractical construction designed to remedy the same defects in the books of the prior art, which defects were subsequently eliminated by Mr. Levison. *To maintain that the step taken by Mr. Levison was an obvious one is also to maintain that Bengough deliberately took out a patent on an impractical book, notwithstanding it was obvious how to construct a practical one.*

As said by the Court of Appeals for the Third Circuit in *Edison Electrical L. Co. vs. Novelty Incandescent Lamp Co.*, 167 Fed., 982:

“Not a few inventors, including Mr. Edison himself, had for some time been busied in the effort to

secure a satisfactory arrangement of leading-in wires, and the different means taken for doing so, better than anything else, shows the complexity of the problem involved, and that in order to meet it something more than ordinary skill was required. To deny its successful solution the merit of invention upon the contrary idea *is to declare that these efforts were needless, and that there was already disclosed in the art an easy and obvious way out, which ought to have been, but somehow was not seen.* We are not, however, to be persuaded to that view."

Regarding Exhibit L, and comparing it with Exhibit 14, a book made in accordance with the patent sued on, Mr. Harry Levison said:

"A. *The thing aimed at in all the previous books was the purpose of getting a triplicate copy with the least amount of handling carbons.* This particular book here is made up with two pieces of carbon bound in the center of the book or between a series of sheets that extend one-half the length of a series of sheets following. The long sheets are folded in the center and placed between the two pieces of carbon, and by writing upon the short sheet you obtain a carbon impression on the two other sheets. The book is worked from the center. After the impression is made you tear out the two sheets in the center of the book and leave the carbon in place for the writing on the other sheets. I have never seen this book on the market, no doubt because it was an awkward book to handle. The

handling of the two carbons in the book appear to me to be even more awkward than handling loose carbons. In Exhibit 14 there is one carbon attached to the book, where in this book here there are two pieces of carbon attached to the book. The fact that the carbon is bound in the center of the book and that you work from the center to the outside of the book makes it obvious that when you reach the outside edge, the sheets, through being such a thickness of stubs between the sheet that you write on and the sheet upon which the impression is to be taken, that the register is not perfect; and furthermore, the thickness of the stubs at the binding space makes a hollow surface upon which to write; therefore the writing would not be as clear; one is apt to punch a hole through the sheets with his pencil. The register is not likely to be perfect, and the fact of binding, confining these two pieces of carbon and separating them in order to place your sheets in proper position is just as awkward to handle as to place two pieces of loose carbon. In defendant's Exhibit 14 of the Peerless book the carbon is always in the proper place and need not be handled. Another thing about this book is that there is just this one set of carbons to bind in the book, and if the book is made of any particular thickness, why, the carbons are apt to be worn out before you reach the end of the book; where, in the book defendant's Exhibit 14, the Peerless book, by interspersing the carbons you can make the book of any thickness you want. In this book it is impossible to get a good book and make the book as thick as it might be required" (Rec., 222-224).

Exhibit M is a book made in accordance with the Perry patent, defendant's Exhibit 6 (Rec., 224). This patent was also issued in 1896.

Regarding Exhibit M, and comparing it with the Levison book, Exhibit 14, Mr. Levison testified as follows:

"A. This particular book is also contrived with the idea of making the handling of carbon easier than the previous patents. While this patent—that is, the Perry patent—is not on the book, the patent is on the manner in which the sheets are printed, and it does not provide in the patent that the sheets be bound in any particular way. The patent merely calls for the transverse printing on the middle copy. In order to do this it is necessary to use a transparent sheet of paper or a very thin sheet of paper, which is not a practical sheet of paper to be used in the business world; and you use it by folding the middle section over the inner section and then reversing the fold and folding the outer section over the middle section. By placing one piece of carbon paper which is carbonized on both sides between the middle and inner section, you get your three copies with the one writing. As I said before, this here requires the use of thin paper, which cannot always be used in business. The carbon is loose and cannot be attached to the book owing to the fact that the third copy remains in the book, and it is impossible to bind or attach a piece of carbon to that book. To my knowledge I have never seen this book on the market, and probably for the

reason that it can only be used with this thin paper. The defendant's Exhibit 14 can be used with any kind of paper of reasonable thickness, and therefore is adaptable to all business purposes. Defendant's Exhibit 14 provides for a book with the carbon held in place or attached to the book. This is with the loose carbon, but this merely shows an effort on the part of the inventor to provide some means of doing away with the handling of several sheets of carbon, but it has never been used to my knowledge.

"Q. 35. In using a single loose sheet of carbon with this book just referred to, and folding the three sections of paper in the manner shown in this book, why is it necessary to have the paper so thin?

"A. Because they use but one piece of carbon, and they place that between the second and third fold. The carbon impression is taken on the back of the second fold or middle sheet, and the impression must be seen through the sheet in order to be read properly and read on the right side of the sheet. The papers merely call for the printing, call for the taking of an impression of the printing on the back of the sheet so that it will be seen through on the front" (Rec., 225-226).

The Brown patent, issued in 1897, is in evidence as defendant's Exhibit No. 4 (Rec., 317). This patent illustrates still another expedient resorted to for the purpose of remedying the defects in the books of the prior art by eliminating the use of loose carbons. The book is made up of a series of leaves, there being in each series three sheets. It is said in the Brown patent:

“In the method now generally employed for making duplicate or triplicate receipts, cash or memorandum tags, where more than one copy is desired, it is customary to employ independent sheets of carbon-paper, which are laid between the upper and lower sheets, so that when a mark or entry is made upon the upper sheet it will be transferred by means of the carbon surface of the next sheet below and this again to a third sheet by the use of a second sheet of carbon. *These carbon sheets are necessarily loose and changeable from one part to another of the book, pad or other record for the purpose of each new entry* and are somewhat expensive to produce.

“In my invention I print or apply upon the back of a sheet by means of any printing-press or other suitable means a surface of non-drying and transparent ink, which when superposed over another sheet will transfer any entries or marks made upon the front side of said sheet or upon any sheet anterior thereto to a subsequent sheet, which may be placed below the one having the above-described surface.”

It will be noted that in this Brown book, the backs of the sheets, having the printed receipt forms thereon, are carbonized, so that the entries made on a sheet are transmitted to the sheet below. Regarding this feature of the Brown book, the witness Levison said:

“This book has not taken very favorably, inasmuch as the back of the paper, being made of thin non-drying ink, was smutty and dirty, and filthy to

everything that it came in contact with, and not only smutty and dirty, but it smutted and dirtied the book in which it was bound and also smutted and dirtied the papers or anything that might be lying about it, after it had been detached from the book" (Rec., 227).

The Brown book is practically an abandoned construction and is no longer on the market (Rec., 229-230).

This Brown patent clearly demonstrates that the step taken by Levison was not an obvious step. As seen from the above quotation from the Brown patent, he appreciated the defects in the triplicating books of the prior art, due to the use of loose carbons therein, and was endeavoring to correct such defects. His efforts in this direction only resulted in an obviously impractical book. Can it be successfully maintained that the step, subsequently taken by Levison, was obvious to Brown? If it was obvious to him, why did he not take it instead of securing a patent on such an impractical construction?

Exhibit P is made in accordance with Fig. 2 of the Doughty patent, defendant's Exhibit No. 2 (Rec., 235). This patent was issued in 1898. The complicated construction of this Doughty book clearly shows that "*the simplicity of the Levison book confirms rather than detracts from the invention, something more than ordinary mechanical skill being required to go so directly to the mark.*"

Regarding the Doughty book, and comparing it with the Levison book, the witness Harry Levison testified as follows:

"This book is made of a series of sheets which are printed so as to permit the folding over of the sheet on the arm, the metal arm. *A metal arm of some kind is attached to the outer edge of the book, and the carbon is attached to the outside or the end of the arm.* In order to use this book, it is necessary to take this carbon or this arm upon which lies a piece of carbon and to lay this arm over the two innerside portions of the sheet, fold the outside portion of the sheet over the middle portion, and the middle portion over the inner portion, folding the carbon with it at the same time. After having written upon it it is necessary to unfold the sheet, throw the arm out of the way which holds the carbon, detach your sheets, the two outer sheets from the inner sheet, lay the inner sheet out of the way, unfold the outer edge of the next succeeding sheet, fold your arm back again into position and place your carbon in its proper position, then refold the sheet as described before. This is a laborious task, entirely impracticable, and to my knowledge I have never seen this book on the market. It is very evident that to use this book would require more trouble and more work than it would to use or insert a dozen pieces of carbon in the entire book. Defendant's Exhibit 14 does away with this mechanical work, does away with this arm and all this extensive and extravagant manner with which to hold the carbon to the book. In handling this book

of Doughty you are required to handle the carbon even more than you are required in any of the other books, while in defendant's Exhibit 14 you do not handle the carbon at all. *In this particular book it is shown that there has been an effort made on the part of the inventor to do away with the handling of the carbon, but it is very evident that he did not succeed*" (Rec., 234-235).

Figure 4 of the Doughty patent discloses another construction, even more complicated than that of figure 2. This modified construction is shown in the book marked "Complainant's Exhibit Q" (Rec., 236). No book of this type is on the market.

Exhibit R (Rec., 238) is made in accordance with the Abraham patent, defendant's Exhibit No. 3. This patent, issued in 1899, discloses a duplicating book in which a single carbon, attached to the book, is inserted between the folds of a leaf for the purpose of making an original and one copy of the receipt. It is not a triplicating book and a sheet carbonized only on one side is used with it. This book, therefore, does not contain the elements of the Levison claims charged to be infringed.

ANTICIPATION.

It is apparent that no patent of the prior art discloses the combination of elements set forth in any one of the claims charged to be infringed. It is true that one or more of the elements of said claims may be

found in one prior patent, and other elements in another prior patent, and still others in a third. It is indispensable, however, that all the elements of a claim be found in the same prior patent in order for such patent to operate as an anticipation. If opposing counsel had been able to find one such prior patent disclosing all the elements of the Levison claims, he would not have encumbered the record with so many patent exhibits only remotely relevant to the issues herein.

“ . . . It is no defense to a claim of infringement that one or more elements of a patented combination, or one or more parts of a patented improvement, may be found in one old patent or publication, and others in another, and still others in a third. It is indispensable that all of them, or their mechanical equivalents, be found in the same description or machine, where they do the same work by substantially the same means. *Imhaeuser vs. Buerk*, 101 U. S., 647, 660, 25 L. Ed., 945; *Bates vs. Goe*, 98 U. S., 31, 48, 25 L. Ed., 68; . . .”

J. L. Owens Co. vs. Twin City Separator Co.,
168 Fed., 265.

In *Yesbera vs. Hardesty Mfg. Co.*, 166 Fed., 125, it is said:

“The point to be emphasized is that the law looks not at the elements or factors of an invented combination as a subject for a patent, but only to the combination itself as a unit distinct from its parts”

To the same effect is the case of *Gormully & J. Manufacturing Co. vs. Stanley Cycle Manufacturing Co. et al.*, 90 Fed., 280:

“Of course the claim cannot be defeated by showing that each of its elements, separately considered, was old. The defendants must prove that the combination was old. If they fail in this, they fail irretrievably.”

COMMERCIAL SUCCESS.

The merits of the Levison book are shown by its rapid introduction into commercial use.

To ascertain the general use of this book, the witness H. F. Williams made a house to house canvass, and the results of his investigations are disclosed in complainant's Exhibit C, which contains a statement of the various business houses in this city using the Levison book. The manner in which the witness collected the data set forth in Exhibit C is thus described by him:

“A. In order to be thorough I started on one street, say Pacific street, and I would go up one side and down the other. I would go into every house, irrespective of the fact whether I knew they used our book or not; and I continued on all the streets parallel with Market, down to Market, then I crossed over and went along every street parallel with Market, south of Market, and I stopped at every business house on the streets that run parallel with Market, down to 9th and 10th and Brannan; in fact, to the water front, Channel street, I think

they call it, parallel with Brannan; then I took in all the Mission district; then I took a scattering list, wherever I could rake up any commercial houses on any of the streets, any houses of any kind or shape at all, and this is the result of my work. In addition to that I took all the streets from East street, Davis and Drumm and Front and Battery, clear up to Market, on the north of Market; then on the south of Market I took in East street and every street running up to East and covered every house that I could possibly find that did any shipment or occupied any position in the commercial world" (Rec., 121-122).

Exhibit C discloses the fact that over 90 per cent. of the business houses in the districts covered by the witness use the Levison book exclusively. This is conclusive proof of the superiority of the Levison book over books of the prior art.

"In determining this question [of invention], the fact that the article produced supersedes all other appliances, or that a useful and commercially successful result has been attained, or that the value of the thing patented has been recognized by the public in extensive use, has a controlling, if not conclusive, effect, and it should have, upon obvious principles of justice to one who sees that which he suggests constantly appropriated and used by others. Such is the proof in this case."

Wilkins Shoe-Button Fastener Co. vs. Webb, 89 Fed., 997.

Such is the proof in the case at bar.

The decision above referred to was cited with approval by this Court in its decision in the case of *Morton vs. Llewellyn et al.*, 164 Fed., 693. The Court, through Judge Ross, said:

“Apart from the presumption of novelty that always attends the grant of a patent, the law is that when it is shown that a patented device has gone into general use and has superseded prior devices having the same purpose, it is sufficient evidence of invention in a doubtful case. *The Barbed Wire patent*, 143 U. S., 275, 292, 12 Sup. Ct., 443, 36 L. Ed., 154; *Keystone Manufacturing Company vs. Adams*, 151 U. S., 139, 143, 14 Sup. Ct., 295, 38 L. Ed., 103; *Irvine vs. Hasselman*, 97 Fed., 964, 38 C. C. A., 587; *Wilkins Shoe Button Co. vs. Webb* (C. C.), 587, 89 Fed., 982; *National Hollow B. B. Co. vs. Interchangeable B. B. Co.*, 106 Fed., 693, 707, 45 C. C. A., 544.”

PATENTABLE INVENTION.

The novelty of the Levison book must be admitted. Whether or not it required the exercise of the inventive faculties to devise, originate and construct such novel book is a question of fact capable of determination by evidence. The appellee comes into court with the presumption of law that his patent is good and valid and covers patentable subject matter over everything theretofore known. This presumption arises from the grant and issuance of the patent and is a statutory presump-

tion. In any case, where the question of patentable novelty is close and in doubt, this presumption is controlling.

Morgan vs. Daniels, 153 U. S., 120;
Cantrell vs. Wallick, 117 U. S., 679.

And this presumption is of such legal effect that "evidence to overcome the presumption of invention arising from the issuance of the patent *must be conclusive* on the question."

Requia Co. vs. New Century Box Co., 138 Fed., 903.

However, appellee has not relied upon such presumption alone. He has proved, by uncontradicted evidence, that there was a long felt want in the art for just such a book as is disclosed in his patent; he has proved that the books of the prior art contained certain well-known defects, which were, from time to time, attempted to be eliminated by prior inventors; he has proved that said attempts were not successful; he has proved that his own attempts to eliminate such defects were successful and that his patented book met with immediate and general favor. In view of these facts, can it be said that the step taken by appellee was an obvious step?

His Honor, Judge Van Fleet, held that appellee *did* exercise his inventive faculties in originating the book disclosed in the patent in suit. In view of such find-

ing, can it now be held that the evidence herein proves, *beyond a reasonable doubt*, that appellee did *not* exercise his inventive faculties? Does not the decision of the lower court to the contrary necessarily preclude a finding by this Court that the evidence herein proves, *beyond a reasonable doubt*, that the step taken by Levison did *not* amount to invention?

“This was the conclusion reached by the court below after a careful consideration of all this evidence. It is settled by the repeated decisions of the Supreme Court and of this Court that where the Chancellor has considered conflicting evidence and made his finding and decree thereon, they must be taken to be presumptively correct and unless an obvious error has intervened in the application of the law or some serious or important mistake has been made in the consideration of the evidence, the findings should not be disturbed.”

North American Explorative Co. vs. Adams,
104 Fed., 404;

Tilghmann vs. Proctor, 125 U. S., 136;

Furrer vs. Ferris, 145 U. S., 132.

The Barlow patent, issued as early as 1884, discloses a book, which, in our judgment, most nearly approaches the construction of the Levison book. The defects in the Barlow book, although apparent, and although attempted to be remedied by many others, were not eliminated until Levison, over fifteen years after the Barlow book first came on the market, invented the book covered by the patent in suit.

Since the advent of the Levison book, the Barlow book has practically disappeared from the market. Certainly the simple modification made in the Barlow book by Mr. Levison was not an obvious change or it would have been made years before. Whether a change in a device, which greatly improves it, is an obvious change or not, can be judged only by the conduct of those familiar with the art. Where a device is on the market for many years and it is generally appreciated that the device contains certain defects which from time to time are unsuccessfully attempted to be remedied, and finally such defects are remedied, it is safe to say that the man who makes the necessary change in the device to eliminate such defects is an inventor.

“One criterion of invention is that others have sought and failed, even when the process is so simple, when discovered, that many believe they could have produced it if required. *Walk. Pats.*, Sec. 26.”

Hanifen vs. Armitage, 117 Fed., 849.

“The English patent shows a clumsy device which apparently never went into successful operation. It seems to be conceded that the English structure can not be used as the Jeffrey structure is used without first making several important changes. The proof leaves no doubt on that subject. It is argued that these changes might have occurred to the skilled artisan. That they did not occur to any one until Jeffrey made the invention is evident. They seem simple enough now, but in-

vention depended upon their being successfully wrought out. *In short, in these changes lies the difference between the commercial failure of the English patent and the widely recognized success of the patent at bar.*"

Gormully & J. Mfg. Co. vs. Stanley Cycle Mfg. Co. et al., 90 Fed., 280.

In the case of *Expanded Metal Co. vs. Bradford*, 214 U. S., 381, the Supreme Court, speaking through Mr. Justice Day, recently said:

"It is often difficult to determine whether a given improvement is a mere mechanical advance, or the result of the exercise of the creative faculty amounting to a meritorious invention. *The fact that the invention seems simple after it is made does not determine the question*; if this were the rule many of the most beneficial patents would be stricken down. It may be safely said that if those skilled in the mechanical arts are working in a given field and have failed after repeated efforts to discover a new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor."

As to the significance to be attached to a simple modification that changes failure into success, Judge Coxe, in *George Frost Co. vs. Cohn*, 112 Fed., 1009, affirmed (C. C. A.), 119 Fed., 505, says:

“Here was a situation, say the defendants, where a hard unyielding substance had been tried and found wanting, and where a soft and gripping substance was needed in its place. Rubber possessed all the required qualities and everyone knew it. What was then more natural than to use rubber? This argument has been so often considered by the courts that little of value can be added to the discussion, and, after all, the old answer is the best answer, ‘No one did it before.’ The record shows that for at least ten years prior to Gorton’s invention men skilled in the art were endeavoring to make an operative supporter and several had so far succeeded as to secure patents, but always along the same lines. There were always the metal button, there was always the fabric clamped between two metallic surfaces. Rubber, in almost every conceivable shape and form, was everywhere in use, but no one thought of it. Like a jewel lost in a crowded thoroughfare, multitudes pass it unnoticed, some actually tread upon it, others stop and gaze for a moment, but hurry on, deeming it some worthless tinsel; at last comes one who recognizes its value and picks it up. Others might have done this it is true, but they did not; he did, and is entitled to the prize which he has rescued from the mire. If one should attempt to snatch the gem from the finder on the ground that he passed it frequently and could have picked it up as well as not, he would in all probability be promptly turned over to the police as a thief or a lunatic. It is this capacity for accomplishing results, this faculty of seeing what others fail to see, and hearing what others fail to hear,

which has always distinguished success from failure and the inventor from the mechanic. 'In the law of patents it is the last step that wins,' says the Supreme Court. This is the step which Gorton took."

In *Hancock vs. Boyd & Getly*, 170 Fed., 600, it is said:

"Was the conception of Hardy to incline the plow disc or discs out of a vertical plane invention? . . . It must be and is conceded, all the other elements of the claim in controversy were old and well known prior to the date of the Hardy patent. . . .

"As has been seen, at this late day, with the completed implement before us, with a practical test made demonstrating the ease with which the work is performed by such implement, with a thorough knowledge of the ultimate end sought to be accomplished, the resistance which must be overcome in the doing of the work, and all the knowledge now at hand, it is almost inconceivable why in the experimental stage of designing and manufacturing rotary disc plows the advisability, or, I may say, the absolute necessity, for inclining the plow disc out of the vertical plane was not thought of by some one and employed before the Hardy idea was conceived. But, admitting the simplicity of the idea employed, its almost apparent necessity to accomplish the end sought, and the fact that the change made might have been discovered by mere accident, yet, if it be conceded the idea was new when first employed by Hardy, do these facts detract from its character as invention? . . .

“Mr. Justice Blatchford, delivering the opinion of the Court in *Consolidated Valve Co. vs. Crosby Valve Co.*, 113 U. S., 157, 5 Sup. Ct., 513, 28 L. Ed., 939, said:

“ ‘Richardson’s invention brought to success what prior inventors had essayed and partly accomplished. He used some things which had been used before, but he added just that which was necessary to make the whole a practically valuable and economical apparatus. The fact that the known valves were not used, and the speedy and extensive adoption of Richardson’s valves are facts in harmony with the evidence that his valves contain just what the prior valves lack, and go to support the conclusion at which we have arrived on the question of novelty. When the ideas necessary to success are made known and a structure embodying those ideas is given to the world, it is easy for the skillful mechanic to vary the form by mechanism which is equivalent, and is therefore in a case of this kind an infringement.’ ”

“In the *Barbed Wire Patent Cases*, 143 U. S., 275, 12 Sup. Ct., 443, 36 L. Ed., 154, Mr. Justice Brown, delivering the opinion of the Court, after detailing the steps taken in the manufacture of barbed-wire fence, said:

“ ‘Under such circumstances, courts have not been reluctant to sustain a patent to the man who has taken the final step which has turned a failure into a success. In the law of patents it is the last step that wins. It may be strange that, considering the important results obtained by Kelley in his patent,

it did not occur to him to substitute a coiled wire in place of the diamond-shaped prong, but evidently it did not; and to the man to whom it did ought not to be denied the quality of inventor. There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of the series of inventors, all of whom were groping to attain a certain result, which only the last one of the number seemed able to grasp.'

"Judge Wallace, delivering the opinion of the court in *International Tooth Crown Co. vs. Richmond* (C. C.), 30 Fed., 775, said:

"*'It is not difficult, after the fact, to show by argument how simple the accomplishment was, and by aggregating all the failures of others to point out the plain and easy road to success. This is the wisdom after the event that often forfeits invention, and levels it to the plane of mere mechanical skill. The ingenious argument in this case has not satisfied us that there was no invention in the improvement of Low.'*

"From a consideration of the proofs, exhibits, models, briefs, and arguments in this case in the light afforded by the foregoing authorities, and many others that may be cited, I am clearly of the opinion the conception formed in the mind of Hardy to incline the plow discs out of a vertical plane, as carried out by him in his combination of parts, judged from the results accomplished thereby, was invention, and the claim of the patent in controversy must be upheld unless anticipated in the prior state of the art."

In the case of *Peters vs. Union Biscuit Co.*, 120 Fed., 679, it was said:

“This conclusion leads next to a consideration of the essential nature, in and of itself considered, of the device of the patent, with a view of determining *whether it discloses such inherent simplicity as to be classified as a development of ordinary mechanical skill, or as the result of inventive faculty.* It is true, the paper box in question belongs to a comparatively humble and lowly art. The two elements which compose it are simple and well known, but the union of these two elements in the way and manner and for the purpose disclosed by the patent was obviously not well known at the time of complainant’s invention. The large number of patents and exhibits found in this record looking towards the result achieved by the patentee disclose an unsatisfied need. The art had been diligently practiced for many decades, and divers devices for packing crackers, candy, and other like products had been resorted to, but none of them accomplished the desired purpose. Such being the case, when a patent is finally granted for a device which does accomplish the desired result, the court should not look with disfavor upon it. *Keystone Manufacturing Co. vs. Adams*, 151 U. S., 139, 14 Sup. Ct., 295, 38 L. Ed., 103. The simple scheme of subjecting the two elements before then each separately well known, to a process of unification, consisting of so folding and interfolding them as to create a hitherto unknown unitary structure, was left to the complainant. The argument that this

new and peculiar combination was a mere aggregation of old elements, and a mere product of ordinary mechanical skill, so obvious as to be readily perceived and taken advantage of by those skilled in the art, is, in my opinion, fully answered by the fact that none of the numerous inventors in defendants' line of industry, and none of the skilled artisans engaged for years in that industry, with the problem urgently confronting them, ever did discover its solution. As said in *Loom Co. vs. Higgins*, 105 U. S., 580, 26 L. Ed., 1177, 'It may have been under their very eyes; they may almost be said to have stumbled over it; but they certainly failed to see it, to estimate its value, and bring it into notice.' It seems to me that the step taken by complainant in uniting and unifying the two old elements in question in the way and manner already disclosed was the final step in the line of invention in the industry in question, which turned failure into success, within the true meaning of the doctrine announced in *Barb Wire Patent*, 143 U. S., 275, 12 Sup. Ct., 443, 36 L. Ed., 154. The treatment of the two elements in question, in my opinion, produced a new and useful result. It certainly disclosed a method of producing an old result in a 'more facile, economical and efficient' way; and the case is brought directly within the doctrine announced by the Court of Appeals of the Eighth Circuit in divers cases, and particularly the case of *National Hollow Brake Beam Co. vs. Interchangeable Brake Beam Co.*, 45 C. C. A., 544, 106 Fed., 693. The 'barb' of the *Barb Wire Patent*, *supra*, the 'collar button' of *Krementz vs. S. Cottle Co.*, 148

U. S., 556, 13 Sup. Ct., 719, 37 L. Ed., 558, and the 'dam' of *DuBois vs. Kirk*, 158 U. S., 58, 15 Sup. Ct., 729, 39 L. Ed., 895, are each and all of them very simple devices; but they served a new and useful purpose, and were held by the Supreme Court of the United States to involve patentable invention."

In the case of *Albright vs. Langfeld*, 131 Fed., 473, it is said:

"When the Patent Office has granted a patent to an inventor, the court should not be ready to adopt a narrow or astute construction fatal to the grant, and in cases where there is any doubt the test of practical success is always persuasive evidence of novelty and has great weight in solving the question favorable to the invention. *Keystone Mfg. Co. vs. Adams*, 151 U. S., 145, 14 Sup. Ct., 295, 38 L. Ed., 103. It is always possible, where an inventor has made an improvement upon the familiar article of simple mechanism, and the improvement only involves changes and additions, which afterwards seem simple and unimportant, to allege want of invention, or the result only that which the ordinary mechanic skilled in that particular art could have seen; yet where the difficulties and objections overcome by this improvement, however slight, have been endured by the public for a long time, and numerous efforts have been made to overcome them, without complete success, when a patent is granted for an improvement in that particular article which does overcome such former difficulties and objections, and it has immediately gone into use, the courts have,

as a rule, found in favor of the inventor, and sustained the patent. Examples of patented inventions which have been upheld by the courts, although they differed very little in form, mechanism, or operation from other appliances, are numerous."

To the same effect is the case of *Hutter vs. De Q. Bottle Stopper Co.*, 128 Fed., 284, where it is said:

"In short, the Hutter device seems to have remedied former defects and supplied what was needed, namely a simple, cleanly, durable, cheap and easily manipulated bottle stopper. *The fact that this result was accomplished by a simple change does not detract from its patentability.*"

In the case of *Curtis vs. Atlas Co.*, 136 Fed., 222, Judge Archbald used the following language:

"It is somewhat remarkable that with all the ingenuity and skill, inventive as well as mechanical, which has been brought to bear upon the manufacture of bicycles, so simple and convenient an appliance as the detachable rubber foot-rest devised by the complainant should not have been thought of before. The fact that it had not, and that it has gone into such extended use as was shown, not only proves that it has met a popular and hitherto unfilled demand, but is also persuasive that its discovery involved the exercise of real invention, and not simply the handy skill of the ordinary mechanic, as one might at first be inclined to believe. The invention displayed may not be of a high order, but it was, at

least, sufficient to appreciate the need, and the means for meeting it acceptably, where others had failed, a circumstance which always has weight."

In the case of *Brunswick-Balke Collender Co. vs. Thum et al.*, 111 Fed., 904, Judge Lacombe, speaking for the Circuit Court of Appeals for the Second Circuit, said:

"The improvement of the patent relates to the part of a bowling alley known as the ball returnway or runway, which returns the balls from the pit end of the alley to the players' end. The old style of runway consisted of a track or trough which inclined downwardly all the way from the pit end to the players' end, down which the balls rolled with a speed increasing all the way, and dependent upon the degree of inclination given to the track. . . .

"The facts in the case at bar are closely analogous to those which were before this court in *Schenck vs. Singer Mfg. Co.*, 23 C. C. A., 494, 77 Fed., 841. *The improvement consists in an extremely simple, and, it would seem, perfectly obvious, application of common knowledge as to the law of gravitation.* Were there nothing in the record but the bare statement of facts above set forth, we would be inclined to concur with the court below in the proposition that:

" 'Had any skilled mechanic been asked to perfect a structure that should gradually arrest the momentum of the returning ball, an ascent would obviously have been the structure needed.'

"But in this case, as in the *Singer* case, the evi-

dence shows conclusively, and, indeed, without contradiction, that this very demand for an arrester of the returning ball was before skilled mechanics for many years, and yet no one before Reisky hit upon the device which now seems so obvious. . . .

“So many of these devices are shown that it is apparent that the skilled mechanics were for years trying to find some way properly to retard the ball, and the proof conclusively shows that all of them were unsatisfactory. Not one of them secured retardation by a change of grade of the trough itself, until the patentee disclosed his simple method, which has so commended itself that now, within three years after the issuance of the patent, 90 per cent. of the existing bowling alleys have the new style, or Reisky, returnways. In the face of this evidence, we cannot hold that his improvement is devoid of patentable invention.”

We desire to call particular attention to the foregoing opinion, because it is therein recognized that the question whether or not the inventive faculties have been exercised in the creation of a novel device is a question of fact and not of arbitrary opinion. It will be noted that in this Brunswick case, the lower court treated the question as one of opinion, and held that the inventive faculties had not been exercised in creating the patented device, notwithstanding the proofs clearly showed that many prior inventors had unsuccessfully endeavored to solve the same problem. By reason of the simplicity of the device, the lower court

held that the step taken by the inventor was obvious, although the proofs showed the contrary.

In the case at bar, opposing counsel would have the court hold, as a matter of opinion, that the step taken by Levison was obvious, although the proofs conclusively demonstrate the contrary. We respectfully submit that this question of invention herein should be determined in the light of the proofs, even though, when considered retrospectively, the change made by Mr. Levison, appears very simple.

In the case of *Bowers vs. San Francisco Bridge Co.*, 91 Fed., 381, Judge Morrow says:

“Before taking up these objections to the Schwartzkopff patent, it is proper to state that the burden of proof to show that the Bowers patents and inventions for dredging have been anticipated by prior patents is upon the defendant, who alleges such anticipation, and that the proof in support of the prior patents must be clear and convincing and place the matter beyond a reasonable doubt. As was aptly said in *Vulcanite Co. vs. American Co.*, 34 Fed., 320, where the defense relied on was anticipation and want of patentable novelty:

“The evidence does not satisfy us that the complainant’s contrivance to avoid the danger of slipping on smooth-surfaced composite pavements was anticipated, nor that it lacked patentable novelty. In this respect the case is doubtless near the line, and calculated to inspire doubt. To create doubt, however, is not sufficient to overthrow the presumption.

arising from the patent. The evidence should be satisfactorily convincing.'

"In *American Bell Tel. Co. vs. People's Tel. Co.*, 22 Fed., 313, where it was alleged by the defendant that one Drawbaugh was the prior inventor of Bell's telephone, Judge Wheeler said:

" 'The complainant starts with the presumption of law that Bell, the patentee, was the inventor. . . . Whoever alleges the contrary must assume the burden of proof. Evidence of doubtful probative force will not overthrow the presumption of novelty and originality arising from the grant of letters patent for an invention. It has been frequently held that the defense of want of novelty or originality must be made out by proof so clear and satisfactory as to remove all reasonable doubt.'

"This case was subsequently affirmed by the Supreme Court of the United States in the Telephone Cases, 126 U. S., 2, 8 Sup. Ct., 778.

"In *Philadelphia Trust, Safe Deposit & Insurance Co. vs. Edison Electric Light Co.*, 13 C. C. A., 43, 65 Fed., 554, Judge Wales, speaking of a defendant who sets up new matter, said:

" 'The uniform practice has been to require the defendant to place himself within the exception requiring him to prove his defense beyond a reasonable doubt.'

"In *Manufacturing Co. vs. Lynch*, 71 Fed., 410, Judge Townsend uses the following language:

" 'The burden is upon the defendants to support this affirmative defense by such cogent and conclusive proof as to convince this Court that, if it had

been presented upon the former hearing, it probably would have led to a different conclusion. In several cases the courts have held that such defense must be established beyond a reasonable doubt.'

"In *Electric Mfg. Co. vs. Edison Electric Light Co.*, 10 C. C. A., 106, 61 Fed., 834, Judge Jenkins said:

" 'In the consideration of such new defense of anticipation, regard should be had to the rule that such a defense is an affirmative one, that the burden of proof is upon him who asserts it, and that the grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device described therein, and of its novelty.'

"The Supreme Court has stated the rule in terms not less strong. In *Coffin vs. Ogden*, 18 Wall., 124, Mr. Justice Swayne, speaking of an asserted prior inventor, says:

" 'The burden of proof rests upon him, and every reasonable doubt should be resolved against him. . . . The law requires, not conjecture, but certainty.'

"This rule of evidence is approved in later cases in the Supreme Court. See *Cantrell vs. Wallick*, 117 U. S., 689, 695, 6 Sup. Ct., 970; *Barbed Wire Case*, 143 U. S., 275, 12 Sup. Ct., 443, 450. See also *Bresnahan vs. Leveller Co.*, 19 C. C. A., 237, 72 Fed., 920; *Patent Co. vs. Donnallan*, 75 Fed., 287."

VALIDITY OF PATENT AS A REISSUE.

The validity of the Levison patent is attacked upon the ground that the same was improperly reissued.

The rules governing the reissues of patents, and which are applicable to the facts of this case may be briefly stated as follows:

I. The law does not allow a patentee, by reissue, to expand *the invention* described and intended to be protected in the original patent, because that would be allowing him a patent for more than he invented.

II. The law does allow a patentee, by reissue, to expand *the claims* of his original patent, if such expansion is commensurate with the actual invention described in the original patent.

In the case of *Topliff vs. Topliff*, 145 U. S., 156, we find a thorough and exhaustive examination of this whole subject by Mr. Justice Brown, in which he says:

“The second claim is to some extent a change of the claim of the first reissue. It omits the requirement that the connecting rod shall be secured directly to the axle and bolster so as to cause both ends of the side springs to yield simultaneously, and introduced the half-elliptic springs AA¹ as a new element of the combination. Whether this be an enlargement of the original claim or not, it is for substantially the same invention, and in view of the fact that a reissue was applied for as soon as the mistake was discovered and *before any rights in favor of third parties could be reasonably expected to have attached, or had in fact attached*, we think this reissue is not open to objections which have

proved fatal to so many since the case of *Miller vs. Brass Company* (104 U. S., 350). *It is a mistake to suppose that that case was intended to settle the principle that under no circumstances would a re-issue containing a broader claim than the original be supported.*"

The learned justice then proceeds to review all the principal cases on the subject of reissues that had theretofore been rendered. After such review he concludes as follows:

"From this summary of the authorities it may be regarded as the *settled rule of this Court* that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient *or the claims were narrower than the actual invention of the patentee*, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception; but that such reissues are subject to the following qualifications:

"First: That it shall be for the *same invention* as the original patent, as such invention appears from the specifications and claims of such original patent.

"Second: That *due diligence* must be exercised in discovering the mistake in the original patent, and that if it be sought for the purpose of enlarging the claim the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the

same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.

“Third: That *this Court will not review the decision of the commissioner upon the question of inadvertence, accident or mistake, unless the matter is manifest from the record*, but that the question whether the application was made within a reasonable time is, in most, if not all such cases, a question of law for the Court. *To hold that a patent can never be reissued for an enlarged claim would not only be to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee.* The specifications and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, and no third persons

have in the meantime acquired the right to manufacture or sell what he had failed to claim. *The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation.*"

This case has since been cited with approval in *Freeman vs. Asmus* (145 U. S., 241), *Huber vs. Nelson Manufacturing Co.* (148 U. S., 292), *Corbin Cabinet Lock Co. vs. Eagle Lock Co.* (150 U. S., 43), and *Dunham vs. Dennison Manufacturing Co.* (154 U. S., 111).

The question at issue is whether the reissued claims are an expansion or enlargement of the original invention. It can not be seriously contended that the invention described in the Levison reissue is not the same as that disclosed in the original patent. *The respective drawings appearing in said patents are substantially identical and in the specification of each patent, only that which appears in the drawings is described.* Opposing counsel apparently contends that the words "substantially equal," appearing in the claims of the reissue are not justified by the description of the Levison book contained in the original patent, and for that reason said claims call for a different invention. This contention is puerile.

The three drawings of the original patent are per-

spective views of the Levison book. By actual measurement, the three parts of the respective record sheets are illustrated therein as being substantially equal. By reason of the drawings being perspective views, the second and third parts of the record sheets are shown slightly narrower than the first part for the reason that said parts are supposed to be more distant from the person looking at the book. That said parts are substantially equal is seen from the specification of the original patent.

It is said therein that the "record sheet is first folded " on the outer line of perforations 4, so as to cover about " one-half of the carbon sheet." From this statement, it is seen that the third part of the record sheet is one-half the width of the carbon sheet. It is also said in lines 36 and 37, page 1, that the carbon sheets are about two-thirds the width of the book. It is further said: "The carbon-sheets are of sufficient width to extend over two of said parts."

If the third part of the record sheet is one-half the width of the carbon sheet and the carbon sheet covers the first two parts of the record sheet, and the third part, when folded over, only covers the second part, the three parts are necessarily substantially equal. We, therefore, see that the three parts of the record sheet are not only shown in the drawings of the original patent as being substantially equal, but *are actually described in said patent as being substantially equal.*

It will be noted that in the original patent, the two features of the Levison invention are very clearly described. One of said features is the use of the card-board backings. It is stated in said patent that: "The "card-board backings are an important feature of my "invention," etc. The other feature is set forth as residing in the novel arrangement of the record sheets and carbons. Both of these features combined together are covered by the single claim of the original patent. Said patent does not, however, cover each of these features, when not combined with the other. In this respect, the said patent was inoperative as either one of said two features could be used by any one without infringing the patent.

The law applicable to the reissue of a patent by reason of the claims thereof being inoperative is thus stated in Sec. 219 of *Walker on Patents*:

"Sec. 219. Claims are the only operative parts of specifications. If an inventor has produced two or more inventions so allied that they may properly be secured to him in one letters patent, and if he fully describes all of those inventions in the descriptive part of his specification, but covers only one of them by his claims, then his patent is operative as to one of those inventions, and inoperative as to the others. Inoperativeness of that kind is sufficient to lay the foundation of a right to a reissue. And where an inventor claims his invention only in combination with something else, his patent is inopera-

tive as to that invention alone. Reissues granted in these classes of cases are called broadened reissues. Though the statute does not, under that name, authorize reissues of that kind, they are authorized by the general terms of the law, and have been upheld by the Supreme Court in many cases; and have been expressly approved by that tribunal."

The single claim of Levison's original patent covered the two sub-combinations constituting his invention. As we have seen, neither of said sub-combinations or features of his invention, when not combined with the other, was covered by a claim. Such being the fact, the recent case of *Universal Caster & Foundry Co. vs. Schenck Co.*, 165 Fed., 344, is particularly applicable in reference to Levison's right to a reissue.

In that case it is said:

"Taking another view of the case, the same result is reached. The reissue claims may be considered as covering a sub-combination of the means for restricting the movements of the spring frame and as not embracing the lug-centering means. Such a sub-combination may be covered by a reissue, although embraced in the original patent only as part of the larger combination. In this respect, also, the reissue was valid."

The fact that both of the said features, when combined together, were covered by the single claim of the original Levison patent, clearly shows that Levison in-

tended to and attempted to secure the same as his invention in the original patent.

Levison certainly was diligent in applying for his reissue. The original patent was issued on February 25, 1902. Sixteen days later, Levison's application for the reissue was on file in the Patent Office at Washington. Considering the time it takes for mail to travel from Washington to San Francisco, Levison must have requested his patent solicitor to prepare the application for the reissue almost immediately upon the receipt of the original patent.

Opposing counsel questioned his expert witness as follows:

"Q. 176. Do you find any inadvertence, accident or mistake in these specifications and drawings appearing in the original patent?

"A. None, whatever."

We are not surprised that the witness found no accident or inadvertence in the Levison patent. We are somewhat curious to know how an accident could ever be found in a patent.

The Revised Statutes provide that "Whenever any
 " patent is inoperative or invalid by reason of a defect-
 " ive or insufficient specification . . . if the error
 " has arisen by inadvertence, accident or mistake . . .
 " the Commissioner shall, on surrender of such patent
 " . . . cause a new patent for the same invention

“and in accordance with the corrected specification to
“be issued to the patentee . . .”

The original Levison patent was inoperative because it failed to cover separately the sub-combinations or features constituting the invention. In applying for the reissue, Levison in his affidavit, accompanying the petition for a reissue, set forth the facts constituting the accident and inadvertence by reason of which said original patent failed to contain claims commensurate with the scope of his invention.

In the case of *Coeffield & Son vs. Spears & Riddle*, 169 Fed., 641, it is said:

“As to the technical defenses touching alleged irregularities in the Patent Office in the issuing of the original and reissue patents without proper affidavits and evidence of inadvertence, accident, or mistake, it is to be remembered that no such irregularities will be assumed to have occurred, but, on the contrary, the granting of the patent is *prima facie* evidence that the law has been complied with, and fatal irregularities in the Patent Office must not only be aptly pleaded but shown by full and satisfactory proof. In case the original patent has been surrendered and a reissued one has been granted, it has been held that such office proceedings can only be impeached for fraud. *Stimpson vs. Railroad Co.*, 4 How., 380, 11 L. Ed., 1020; *Battin vs. Taggart*, 17 How., 77, 15 L. Ed., 37; *Seymour vs. Osborne*, 11 Wall., 516, 20 L. Ed., 33.”

INFRINGEMENT.

The appellant's book is made in accordance with United States letters patent, granted on February 9, 1909, to Mr. John Kitchen, Jr., president of the appellant corporation. The Kitchen patent is in evidence as defendant's Exhibit 12.

This book is made up of recording leaves, each divided into three sections by vertical lines of perforations. The leaves and cover of the book are bound together by staples. The double carbon sheets used with the book are each secured at one end to a strip of cardboard notched along its back edge to form points. These points of the cardboard are pushed in underneath the cover of the book and between and on either side of the staples. In his patent, Mr. Kitchen says:

“ . . . the pressure on the points 11 of the stub strip, after the latter has been inserted, *will hold the carbon permanently in position.*”

Regarding these carbon sheets, he also says:

“they are held *firmly* in place just as though they had been *bound* in the book originally.”

The contention of opposing counsel is that in view of the fact that the carbon sheets in appellant's books can be removed without tearing them, they are not bound with the recording sheets. The claims of the Levison patent call for a book having the stubs of the

recording leaves and one side of the carbon sheet bound together.

The determination of the question of infringement depends solely upon the meaning to be attached to the word "bound" in the Levison claims. If the "carbon sheets" of appellant's book are "bound" in the book, the book infringes the Levison patent sued on.

In the Levison patent, *the specific means for binding or holding together the recording sheets and carbon sheets are not described*. The Levison invention does not reside in the particular means used for holding the said sheets together. The claims, therefore, should not be limited to any particular means used for that purpose. All "binding means" are included within the scope of the Levison claims.

Regarding this matter, the witness, Harry Levison, testified:

"Q. 57. What is meant by the words or expression 'to bind'? Or the word 'bound' in the art of which the various exhibits form a part?

"A. Do you mean to use the word 'bind' in the art of making these books. I would say that the word 'bind' means anything that is attached to, that is held; in other words, if you would take a dictionary you would find that the definition of the word 'bind' is to confine or restrain or hold by physical force or influence of any kind; to be restrained from motion or from customary or natural action. Therefore anything that is restrained in any manner or by any influence is bound.

"Q. 58. Are there various means used in the art for binding the leaves of a book or loose leaves, together? And if so, state some of those various means?

"A. There are, yes. They can be bound either by glue, paste, sewing, stitching, by clamping, by friction, or by pressure. Any of those things would bind" (Rec., 238).

"Q. 62. (By Mr. White.) I hand you a catalogue of the Barrett Bindery Co. and ask you to state whether or not the same discloses various and sundry means of binding objects together other than by stitching?

"A. It does. In the very first page of this book it heads off with large letters, 'Binders that Bind.' And the first one that is put in there is the Torsion, the one that is marked 'Exhibit T.' And as you go through the book you will find that he shows a binder on page 7 which is held by cords, string, through the holes in the sheet; while on page 13 he describes a book or shows a picture of a book, and on the top of it it is called a spring back binder. This is evidently according to the description, simply a binder which holds sheets in place by a spring, clamping at the binding place. In other words, the sheets of the books are held in place by friction created by a spring clamp" (Rec., 240).

It will be noted that in this art the word "bound" is not used to signify any particular means employed to hold together sheets of paper. The term is a compre-

hensive one and includes any and all means used to hold together sheets of paper.

Regarding the significance of the word "bound" in this art, the appellant's witness Crandall testified:

"XQ. 14. Is it not a fact that in your stock you have binders, what are called binders in catalogues, which bind the leaves together simply by friction or pressure?

"A. Yes" (Rec., 64).

The Doughty patent discloses a spring clamp used for holding the carbon sheet. Regarding the Doughty book, Mr. Kitchen testified as follows:

"XQ. 1. How is the carbon bound in the Doughty book, Mr. Kitchen? By what means?

"A. It is fastened, clamped to the rim by a spring. . . .

"XQ. 4. You say it is bound in the book?

"A. Bound by a spring, yes" (Rec., 175).

It will be recalled that in this Doughty book, the carbon and stubs of the recording sheets are not bound together, as called for in the Levison claims. The Doughty carbon is held in a wire frame which is attached to the cover of the book.

In appellant's book, the carbon sheets are securely bound in place by the spring action of the stubs of the recording sheets. These stubs are pressed together by the staples and, after being pried apart for the purpose

of inserting one end of the carbon sheet, immediately come together again and clamp or bind the carbon sheets firmly in position. The carbon sheets are, in this manner, says Mr. Kitchen, "held firmly in place just as though they had been *bound* in the book *originally*." Of course it is immaterial whether the carbon sheets in defendant's book are bound in the book after it is made or during the making thereof. The Levison claims simply call for carbons bound in the book. The time of binding them is immaterial.

The appellant's expert witness Maynard testified that appellant's book did not infringe for the sole and only reason that the carbon is not permanently bound therein. In answer to opposing counsel's question he said:

"Q. 46. In what respect do you find that it has not the combination of elements of claim 3?

"A. For the reason that the carbon is not *permanently* bound at any point in the book" (Rec., 53).

This witness therefore admits that the carbon is bound in the Kitchen book, but he says it is not *permanently* bound therein. The Levison claims, however, are not limited to carbons *permanently* bound therein. Nothing is said in the patent about the necessity of the carbons being permanently bound in the book. The claims simply call for carbons bound in the book and the carbons are bound in the defendant's book. It will also be recalled that Kitchen says in his patent that his

carbons are held *permanently* in position. His book therefore infringes the Levison claims.

It is contended by opposing counsel that the appellant's book is an improvement on the Levison book. It is admitted that all the benefits of holding or binding the carbon sheets in place are secured by appellant's construction as well as by the Levison construction, but it is contended that it is of value to be able to remove the carbon sheets and insert others in their place. It is immaterial if the appellant's book is an improvement. We are alone concerned with the fact that it contains all the features of the Levison book.

In *Thomson-Houston Electric Co. vs. Ohio Brass Co.*, 130 Fed., 548, it is said:

"In the case at bar, if the construction with reference to the wires running over the plate should be held to be an improvement on complainant's device, this fact of improvement does not permit the defendants to appropriate the invention of the patents in suit. In *Electric Smelting Co. vs. Reduction Co.*, 125 Fed., 927, the Court say:

"'He (the defendant) does not acquire the right to use the Bradley process, simply because he has improved that process. He is entitled to enjoy what is his, but in so doing he cannot appropriate the property of another . . .'"

CONCLUSION.

We submit that the patent in suit discloses a patentable invention. Mr. Levison "converted imperfection

into completeness" and is entitled to his reward. He remedied the defects in the books of the prior art and "the fact that this result was accomplished by a simple change does not detract from its patentability."

The appellant has undoubtedly embodied the Levi-son invention in its books and has infringed upon claims 3, 4 and 5 of the patent sued on.

Respectfully submitted.

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